UNITED STATES PATENT AND TRADEMARK OFFICE

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Keller Jolley Preece/Facebook
1010 North 500 East
Suite 210
North Salt Lake, UT 84054

EXAMINER
OBAID, FATEH M

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte JEFFREY JONATHAN SPURGAT,
STEPHEN CHRISTOPHER GLADWIN,
and HOYET HARRISON ANDREWS, III

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Appeal 2015-005450
Application 13/019,783
Technology Center 3600

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Before ANTON W. FETTING, BRUCE T. WIEDER, and
KENNETH G. SCHOPFER, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE[1]

Jeffrey Jonathan Spurgat, Stephen Christopher Gladwin, and Hoyet

Harrison Andrews, III (Appellants) seek review under 35 U.S.C. § 134 of a

Final Rejection of claims 2, 3, 8–13, and 17–20, the only claims pending in

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[1] Our Decision will make reference to the Appellants' Appeal Brief ("App.
Br.," filed October 22, 2014) and Reply Brief ("Reply Br.," filed April 28,
2015), and the Examiner's Answer ("Ans.," mailed March 13, 2015), and
Final Office Action ("Final Act.," mailed June 13, 2014).

the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

The Appellants invented an audio gateway device. Spec. para. 2.

An understanding of the invention can be derived from a reading of exemplary claim 2, which is reproduced below (bracketed matter and some paragraphing added).

> 2. A method comprising:
> [1] detecting a connection by a mobile player to a computer system by way of a wireless communications link;
> [2] detecting content collection information stored on the mobile player;
> and
> [3] transmitting,
> > based on the detected content collection information stored on the mobile player,
> > the content collection information to at least one other player that is connected to the computer system by way of a wireless communication link.

The Examiner relies upon the following prior art:

Janik   US 2002/0013852 A1   Jan. 31, 2002

Claims 2, 3, 8–13, and 17–20 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 2, 3, 8–13, and 17–20 stand rejected under 35 U.S.C. § 102(e) as anticipated by Janik.

ISSUES

The issues of eligible subject matter turn primarily on whether the claims are directed to more than the conceptual idea of transcribing

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information. The issues of novelty turn primarily on whether Janik

describes receiving and transmitting content information from one wireless

device to another via a personal computer.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be

supported by a preponderance of the evidence.

Facts Related to the Prior Art

Janik

01. Janik is directed to providing user specified channels for moving
content from the Internet and local storage device to one or more
networked devices for access by end users. Janik para. 2.

02. Janik describes content and data delivered to a variety of devices
via a caching gateway device and a local area network. Software
residing on a PC or PC in combination with a storage gateway
device provides content distribution, management, and interaction
functions. Janik para. 2.

03. Janik describes delivering content, data, and application services
to a variety of thin client devices. Janik allows end users to
program preference-based content for delivery at various client
devices, and then to automatically or under the control of the user,
send the content to client devices for presentation to the end user.
Janik para. 27.

04. Janik describes the high-speed LAN connection 70 between PC
34, storage gateway 38, and devices 78, as a HomeRF wireless
network. Janik para. 73.

05. Janik describes content 10 on Internet 8 being arranged for delivery to local client devices 78a, b, c, and d, by a system that allows for graphical icons, referred to in this disclosure as content objects 20 that exist on content selection web page 22, to be dragged and dropped onto content editors on a PC 34. Drag and droppable content object 20 is a graphical representation of a file system path that points to a digital content file stored locally on hard disk drive 30 on PC 34 or on storage gateway 38, or on a server on Internet 8, or is the graphical designation of a URL or IP address and port number of a digital content stream originating on a server on Internet 8. The purpose of the portal is to simplify and facilitate the discovery and selection of content 10 from Internet 8 for later use on client devices 78. Janik para. 74.

06. Janik describes an audio playback device as an example of its client devices. Janik paras. 108 and 117. The audio playback device uses a wireless data connection. Janik para. 118.

07. Janik describes providing content and other information services to thin client devices implemented with just PC 34. LAN 70 is established by the use of a HomeRF wireless LAN access point 54. Janik para. 186.

08. Janik describes content 10 being automatically accessed, downloaded and cached on PC 34, and then automatically streamed to client devices 78. Janik para. 187.

ANALYSIS

*Claims 2, 3, 8–13, and 17–20 rejected under 35 U.S.C. § 101 as directed to
non-statutory subject matter*

The Supreme Court

> set forth a framework for distinguishing patents that claim laws
> of nature, natural phenomena, and abstract ideas from those that
> claim patent-eligible applications of those concepts. First, . . .
> determine whether the claims at issue are directed to one of those
> patent-ineligible concepts . . . . If so, we then ask, "[w]hat else is
> there in the claims before us?" . . . To answer that question, . . .
> consider the elements of each claim both individually and "as an
> ordered combination" to determine whether the additional
> elements "transform the nature of the claim" into a patent-
> eligible application . . . . [The Court] described step two of this
> analysis as a search for an "'inventive concept'"—*i.e.*, an
> element or combination of elements that is "sufficient to ensure
> that the patent in practice amounts to significantly more than a
> patent upon the [ineligible concept] itself."

Alice Corp., Pty. Ltd. v CLS Bank Intl, 134 S. Ct. 2347, 2355 (2014) (citing

Mayo Collaborative Servs. v. Prometheus Labs., Inc., 566 U.S. 66 (2012)).

To perform this test, we must first determine whether the claims at

issue are directed to a patent-ineligible concept.

While the Court in *Alice* made a direct finding as to what the claims

were directed to, we find that this case's claims themselves and the

Specification provide enough information to inform one as to what they are

directed to.

The preambles to claims 2 and 11 do not recite what the method is

directed to, but the steps in claims 2 and 11 result in copying content. The

Specification at page 1 recites that the invention relates to synchronizing the

digital audio content and playlists between the digital audio playback devices. Thus, all this evidence shows that claims 2 and 11 are directed to copying content, i.e., transcription.

It follows from prior Supreme Court cases, and *Bilski* in particular, that the claims at issue here are directed to an abstract idea. Like the risk hedging in *Bilski*, the concept of transcription is a fundamental business practice long prevalent in our system of commerce. The use of transcription is also a building block of any literate society. To the extent the content is audio or video content, this practice is at least as old as tape recorders, which were routinely used to copy audio from long playing records back in the 1950's and 1960's. In the more general context of content including written words, this practice is as old as the employment of scriveners. Thus, transcription like hedging, is an "abstract idea" beyond the scope of § 101. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2356.

As in *Alice Corp. Pty. Ltd.*, we need not labor to delimit the precise contours of the "abstract ideas" category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of collecting and storing data, which has previously been determined to be an abstract idea (*see Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1346–47 (Fed. Cir. 2014)) and the concept of transcription at issue here. Both are squarely within the realm of "abstract ideas" as the Court has used that term. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2357.

Further, claims involving data collection, analysis, and display are directed to an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that "collecting information, analyzing

it, and displaying certain results of the collection and analysis" are "a familiar class of claims 'directed to' a patent ineligible concept"); *see also In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016). Claim 2, unlike the claims found non-abstract in prior cases, uses generic computer technology to perform data collection, analysis, and transmission and does not recite an improvement to a particular computer technology. *See, e.g., McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (finding claims not abstract because they "focused on a specific asserted improvement in computer animation"). As such, claim 2 is directed to the abstract idea of receiving, analyzing, and transmitting data.

The remaining claims merely describe the type of content and devices. We conclude that the claims at issue are directed to a patent-ineligible concept.

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two.

> the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea "while adding the words 'apply it'" is not enough for patent eligibility. . . . Nor is limiting the use of an abstract idea "'to a particular technological environment.'" . . . Stating an abstract idea while adding the words "apply it with a computer" simply combines those two steps, with the same deficient result. Thus, if a patent's recitation of a computer amounts to a mere instruction to "implement[t]" an abstract idea "on . . . a computer," . . . that addition cannot impart patent eligibility. This conclusion accords with the pre-emption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers . . . , wholly generic computer

> implementation is not generally the sort of "additional feature[e]" that provides any "practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself."

Alice Corp. Pty. Ltd., 134 S. Ct. at 2358 (internal citations omitted).

"[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer." *Alice Corp. Pty. Ltd.,* 134 S. Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to detect connections and content are among the most primitive operations, and to receive and transmit data amounts to electronic data query and retrieval—one of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellants' method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellants' method claims simply recite the concept of transcription as performed by a generic computer. To be sure, the claims recite doing so by advising one to transmit certain data based on the type of connection and content. But, this is no more than abstract conceptual advice on the parameters for such transmission and the generic computer processes necessary to process those parameters, and do not recite any particular implementation.

The method claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in

any other technology or technical field. The 34 pages of written description in the Specification spell out different generic equipment and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of transmitting data under different criteria. They do not describe any particular improvement in the manner a computer functions. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of transcription using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.,* 134 S. Ct. at 2360.

We are not persuaded by Appellants' argument that the claims are directed towards a computer system for use in a wireless network that includes detecting a connection by a mobile player to the computer system, detecting or otherwise receiving content collection information stored on the mobile player, and transmitting the content collection information to at least one other player based on the detected/received content collection information stored on the mobile player. Reply Br. 3–4. Again, this is no more than transcription. Simply using a communication device as it is designed adds nothing concrete to the claim. *See In re TLI Commc'ns,* 823 F.3d at 612–13 (Using a generic telephone for its intended purpose was a well-established "basic concept" sufficient to fall under *Alice* step 1.)

Claims 2, 3, 8–13, and 17–20 rejected under 35 U.S.C. § 102(e) as anticipated by Janik

Claims 2 and 11, the only independent claims, are both method claims and are similar, but phrased slightly different. The first step in claim 2

detects a connection by a mobile player to a computer system. The first two steps in claim 11 recite steps inherent in forming that connection, *viz.* detecting the wireless device (inherent in the basic input/output connection protocol) and then establishing the wireless communication link (inherent in the wireless network protocol). Neither claim recites nor narrows the implementation for detecting or the time frame for that relative to the remaining steps. Although claim 2 recites a mobile player, this is not further narrowed or structurally defined, and so any player that may be moved, such as because it uses a wireless connection, is within the scope. In particular, Janik's wireless storage gateway, which is simply a hard drive connected by a wireless link, is small enough to be considered portable, given the sizes of stand-alone commercial hard drives for use by personal computers.

The second step in claim 2 then detects content on the mobile player, whereas the comparable step, the third, in claim 11 receives information about that content. Again, implementations are neither recited nor narrowed. The content detection in claim 2 is a necessarily inherent step of receiving the content in claim 11, as any file system tests for data presence prior to file access.

The final steps in each claim transmit that content to another device. And again, implementations are neither recited nor narrowed. The claims actually refer to content information, rather than just content, but content information itself is content, so the nature of the content or content information is immaterial.

Thus, both claims see whether there is content to be copied, and if so, copy the content. Because the claims do not recite how the detection occurs, detection as a result of human commands is within the scope.

Janik describes content received from a wireless storage gateway that is transmitted to wireless audio playback devices by a PC. Thus, Janik describes both claims 2 and 11.

We are not persuaded by Appellants' argument that Janik does not disclose "detecting content collection information stored on the mobile player," as recited in independent claim 2. App. Br. 8. Again, this is an inherent aspect of the file access Janik describes on its storage gateway. To the extent Appellants contend that Janik requires human intervention by selecting content, this is within the scope of the claims as drafted because no implementation is recited.

We are not persuaded by Appellants' argument that Janik does not disclose transmitting, based on the detected content collection information stored on the mobile device, the content collection information to at least one other player that is connected to the computer system by way of a wireless communication link. App. Br. 9. Janik describes transmitting the selected (detected) content from its storage gateway to its audio playback device. As this is based on the selected content, the transmission is based on the detected content collection information stored on the mobile device.

We are not persuaded by Appellants' argument as to claim 11 that Janik does not disclose transmitting, based on the received information about the content collection stored on the second device, the information about the content collection to a third device for the same reasons supra with respect to claim 2. App. Br. 11.

We are not persuaded by Appellants' argument that in regards to claim 3, Janik does not disclose detecting and transmitting content collection information where the content collection information includes an

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identification of a multimedia content sequence on the mobile player and a position in the multimedia sequence that is currently playing on the mobile player. App. Br. 12. No manner of identification is recited. Thus, Janik's content transmission itself is a sequence and that sequence itself identifies the content. Further, as the content is played on the playback device, the position of playback is also necessarily inherent.

We are persuaded by Appellants' argument that in regards to claim 8, Janik does not disclose that content collection information is received as part of a broadcast message by the mobile player. App. Br. 13. The Examiner cites the AM/FM tuner in Janik's playback device. Final Act. 3. Such signals are not part of the content information received from a mobile device.

CONCLUSIONS OF LAW

The rejection of claims 2, 3, 8–13, and 17–20 under 35 U.S.C. § 101 as directed to non-statutory subject matter is proper.

The rejection of claims 2, 3, 9–13, and 17–20 under 35 U.S.C. § 102(e) as anticipated by Janik is proper.

The rejection of claim 8 under 35 U.S.C. § 102(e) as anticipated by Janik is improper.

DECISION

The rejections of claims 2, 3, 8–13, and 17–20 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED